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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,914	06/14/2000	Jens J. Hyldig-Nielsen	BP9901US	8319
23544	7590	10/26/2004	EXAMINER	
BRIAN D. GILDEA APPLIED BIOSYSTEMS 15 DEANGELO DRIVE BEDFORD, MA 01730			MYERS, CARLA J	
			ART UNIT	PAPER NUMBER
			1634	

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

**Application No.**

09/593,914

**Applicant(s)**

HYLDIG-NIELSEN ET AL.

**Examiner**

Carla Myers

**Art Unit**

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 10, 12, 16, 18, 19, 21-29, 32, 34, 46-49, 61, 62 and 80-87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-8, 10, 12, 16, 18, 19, 21-29, 32, 34, 46-49, 61, 62, 80-87 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

Art Unit: 1634

1. In view of the Petition Decision of August 3, 2004, PROSECUTION IS HEREBY REOPENED. A new restriction requirement is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

#### **Election/Restrictions**

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 10-12, 16, 18, 19, 21-29, 32, 61, 62, 86 and 87, drawn to probes and methods of using probes wherein said probes comprise **SEQ ID NO: 1**, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

II. Claims 10-12, 16, 18, 19, 21-29, 32, 61, 62, 86 and 87, drawn to probes and methods of using probes wherein said probes comprise **SEQ ID NO: 2**, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

III. Claims 10-12, 16, 18, 19, 21-29, 32, 34, 61, 62, 86 and 87, drawn to probes and methods of using probes wherein said probes comprise **SEQ ID NO: 3**, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

Art Unit: 1634

IV. Claims 10-12, 16, 18, 19, 21-29, 32, 34, 61, 62, 86 and 87, drawn to probes and methods of using probes wherein said probes comprise **SEQ ID NO: 4**, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

V. Claims 10-12, 16, 18, 19, 21-29, 32, 34, 61, 62, 86 and 87, drawn to probes and methods of using probes wherein said probes comprise **SEQ ID NO: 5**, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

VI. Claims 10-12, 16, 18, 19, 21-29, 32, 34, 61, 62, 86 and 87, drawn to probes and methods of using probes wherein said probes comprise **SEQ ID NO: 6**, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

VII. Claims 10-12, 16, 18, 19, 21-29, 32, 61, 62, 86 and 87, drawn to probes and methods of using probes wherein said probes comprise **SEQ ID NO: 7**, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

VIII. Claims 10-12, 16, 18, 19, 21-29, 32, 61, 62, 86 and 87, drawn to probes and methods of using probes wherein said probes comprise **SEQ ID NO: 8**, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

IV. Claims 10-12, 16, 18, 19, 21-29, 32, 61, 62, 86 and 87, drawn to probes and methods of using probes wherein said probes comprise **SEQ ID NO: 9**, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

X. Claims 10-12, 16, 18, 19, 21-29, 32, 61, 62, 86 and 87, drawn to probes and methods of using probes wherein said probes comprise **SEQ ID NO: 10**, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

Art Unit: 1634

XI. Claims 10-12, 16, 18, 19, 21-29, 32, 61, 62, 86 and 87, drawn to probes and methods of using probes wherein said probes comprise **SEQ ID NO: 11**, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I-XI are drawn to distinct probes each comprising a unique nucleotide sequence and thereby each having unique functional properties. These sequences are thus deemed to constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.14.

While the probes required for the methods of inventions I-XI are each composed of nucleotides, the probes of SEQ ID NO: 1-11 are considered to be unrelated since each of the claimed probe sequences are structurally and functionally distinct from one another. Each probe consists of a distinct nucleotide sequence; each probe binds to a unique target nucleic acid sequence; and each probe has a distinct melting temperature and binding affinity with respect to its target nucleic acid(s). Further, the sequences have additional distinct functional properties in that, for example, SEQ ID NO: 1 and 2 consist of sequences from 18S rRNA, while SEQ ID NO: 3-11 consist of sequences from 26S rRNA. The sequences have different specificities with respect to their ability to hybridize to and detect different species and strains of *Dekkera*. For instance, SEQ ID NO: 1 hybridizes with *D. bruellensis* and *D. nanus*, while SEQ ID NO: 5 reacts with most species of *Dekkera*, as well as with *Mycotorula intermedia* (see page 40 of the

Art Unit: 1634

specification). In view of these differences in structure and function, the Markush/genus of probe sequences in claims 10-12, 16, 18, 19, 21-29, 32, 34, 61, 62, 86 and 87 are not considered to constitute a proper genus, and are therefore subject to restriction.

Furthermore, a search of more than one (1) of the probe sequences claimed in claims 10-12, 16, 18, 19, 21-29, 32, 34, 61, 62, 86 and 87 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed probe sequences.

Inventions I-XI require different searches in the non-patent literature and in sequence databases that are not co-extensive. For example, a search in the sequence databases and non-patent literature for the probe sequences of SEQ ID NO: 1 would not provide a complete search for the probe sequences of SEQ ID NO: 2, and vice versa. Therefore, examination of these distinct inventions would pose a serious burden on the examiner and restriction for examination purposes as indicated is proper.

In addition, if applicants elect Group III, IV, V or VI (i.e., SEQ ID NO: 3, 4, 5 or 6, respectively) Applicants should elect a second nucleic acid sequence selected from SEQ ID NO: 3-6 to be examined with respect only to claim 34. It is noted that claim 34 has been interpreted as requiring a set of 2 probes, wherein the 2 probes are selected from the group consisting of SEQ ID NO: 3-6.

5. Claims 1-8, 46-49 and 80-85 link(s) inventions I-XI, as set forth above. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s). Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending

Art Unit: 1634

from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.0.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

7. With respect to the previous restriction requirement, on April 26, 2001, a provisional election was made with traverse to prosecute the invention of group I and to examine the probes comprising SEQ ID NO: 1. Applicants have already received an office action on the elected invention of Group 1 and the probes of SEQ ID NO: 1.

Since applicant has received an action on the merits for the originally elected invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, while this restriction requirement may be traversed, Applicant is

Art Unit: 1634

required to confirm the election of Group 1 and the subject matter of SEQ ID NO: 1 in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carla Myers whose telephone number is (571) 272-0747. The examiner can normally be reached on Monday-Thursday from 6:30 AM-5:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (571)-272-0782.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Carla Myers  
September 20, 2004

  
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PRIMARY EXAMINER

  
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